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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>013284-05551</b>	
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>49,083</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>[Signature]</u> Signature <u>Patricia E. McQueeney</u> Typed or printed name <u>(954) 233-4000</u> Telephone number <u>November 13, 2000</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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Application Serial No.: 097637,388  
Applicants: James B. Riley et al.  
Filed: August 11, 2000  
Title: Electronic Note Taking Systems and Methods  
GAU: 2178  
Examiner: Gregory J. Vaughn  
Docket No.: 013284-05551

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Responsive to the Final Office Action dated August 10, 2006 as entered in the above-captioned matter, Applicants hereby submit this Pre-Appeal Brief Request for Review and respectfully request allowance of the above-captioned application. The appropriate appeal fee is being submitted concurrently herewith.

## 35 U.S.C. § 112, 1st

The Examiner maintains his rejection of claims 73, 77 and 81 for failure to comply with the written description requirement of 35 U.S.C. § 112, 1<sup>st</sup> paragraph because he reasons that 'prohibiting' is not the same as 'not using.' "Just because a person is not using something does not mean that the person is prohibited from using it." Applicants agree with the Examiner's statement but disagree with the Examiner's conclusion. As discussed in detail below, the disclosure of the original application conveys to an artisan that Applicants had possession of the claimed subject matter as of the filing date and is therefore compliant with the written description requirement. MPEP § 2163.02.

Applicants included and the Examiner cites to the following passage in the original specification as support for the claim language: "This enables the user to copy and access the notes when *not using* the original document or course" (emphasis added). Many situations may prevent a person from using something, including a conscious decision not to use something or an inability to use something due to a prohibition. For example, when using a laptop computer, internet access may not be available or, if available, the electricity that powers the internet connection may be out, prohibiting network access. In that situation, access to the notes is maintained even though access to the linked documents is not. Furthermore, such occurrences would be obvious to one of ordinary skill in the art.

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Another reason that access may be prohibited includes the situation in which the person no longer has access to the original course or documents utilized therein. Just because a person has taken a course in Chemistry 101 does not mean that he/she can attend that course forever. This phenomenon does not change if the course is provided online (see page 2, lines 26-28 "The Web is well suited for providing educational programs to users located all over the world."). If a student cannot perpetually attend a course off-line, he or she may not do it online either.

Today, many students take notes on computers. The students may include links to online course materials in the notes. However, after completion of the course, access from the notes to the online materials may be prohibited. One of ordinary skill in the art would recognize many reasons for this prohibition including, but not limited to, the fact that the user has not paid to attend the current course, that the professor under whom the notes were taken is no longer teaching the course, that the professor has changed the location of the online materials, that the course has been totally restructured and is no longer provided in the manner it was provided when the notes were taken, etc.

In addition, claim 16 as originally filed limited "not using" to the situation where a user downloads the notes onto his or her computer. Applicants did not find a similar provision in the Examiner's anticipatory reference U.S. Pat. App. Pub. No. 2003/0196164 to Gupta et al. (hereinafter "Gupta"), in which the notes are stored on an annotation server, not at the user's location. As depicted in Gupta, a user could not access his or her notes if the internet were down. In the present invention, the user may still access his or her notes, but not the linked material, when internet access is not available.

Page 2, lines 28-30 of the specification discusses students "logging on" and participating in learning programs online. In that situation, a user could forget their login name or password and not have access to the original document or course. This example provides another embodiment of "prohibited access" that is clearly supported in the specification. In other words, a user's access is prohibited if he or she can't remember how to access the site.

Another prohibition embodiment is depicted at page 8, lines 16-28. In this embodiment,

the notes or other annotations may be stored on, for example, hard-disks, floppy disks, tapes, recordable optical storage media, in RAM, or on any other suitable storage device. If desired, pointers, links, universal resource locators (URLs), identifiers, or other indicators of source documents (e.g. word processing documents, spreadsheets, web pages, etc.) may be stored to associate notes or other annotations with source documents.

Once again, one of ordinary skill in the art would understand that, in this embodiment, the user may not always have access to the source documents. For one reason, the link to the source document is

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*optional.* For another reason, if the link were included, the user may still not be able to access the source documents. Once again, one of ordinary skill in the art would recognize that the internet may not be working, or a storm may remove a user's electricity, or the user may have forgotten his password for the website, or the course content may have changed, or the user may no longer have and be prohibited access to the course because the course was taken ten years ago.

In summary, Applicants submit that the present rejection is improper because adequate support for the claim language exists in the original application. Therefore, the present rejection should be withdrawn.

**35 U.S.C. § 112, 2nd**

The Examiner maintains his rejection of claims 73, 77 and 81 as indefinite under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph because the term "prohibiting access" is a relative term which renders the claim indefinite. Two requirements are necessary to satisfy 35 U.S.C. § 112, 2<sup>nd</sup> paragraph; (1) the claims must set forth the subject matter that applicants regard as their invention, and (2) the claims must particularly point out and distinctly define the metes and bounds of the subject matter. MPEP § 2171. In the Response to Arguments section of the Office Action dated August 10, 2006, the Examiner concedes that the normal definitions accorded to the terms are acceptable. Therefore, the Examiner and Applicants agree that the claim language particularly points out and distinctly defines the metes and bounds of the subject matter.

The Examiner, however, states that the specification fails to point out how the prohibition is achieved. "The content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention." M.P.E.P. § 2172 (II). Therefore, the present rejection is not proper and should be withdrawn.

However, to address the Examiner's concerns, which actually appear to be directed to enablement under 112, 1<sup>st</sup> paragraph and not indefiniteness under 112, 2<sup>nd</sup> paragraph, the claims of the present invention are enabled and consistent with the original disclosure of the invention. The Supreme Court summarized the test for enablement as "is the experimentation needed to practice the invention undue or unreasonable?" Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916). This standard is still applied today. MPEP § 2164.01. Applicants submit that no experimentation is necessary because one of ordinary skill in the art could easily make and use the claimed invention.

The present invention provides an annotation tool for use with online courses. The present specification also describes an online course-authoring method, which is claimed in co-pending patent application 11/008,132. Several locations in the specification provide instruction as to how a

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prohibition could be obtained. For example, at page 12, lines 25 et seq., the notes "may be stored at the course provider's location (e.g. the course provider's Internet server)." Any internet service provider ("ISP") knows how to prohibit or block access to specific users or groups of users when necessary, and knew how at the time the original application was filed. Therefore, prohibition could be achieved by an ISP according to its normal operating procedures.

At page 14, lines 12-15, "[a]uthors or other parties may review notes to determine whether courses should be discontinued,...." One of ordinary skill in the art would recognize that when linked content is "discontinued," it is no longer accessible. Would that access be prohibited? Yes, because the content would no longer be there.

Finally, at page 15, lines 30 et seq., the specification discloses that an instructor may password protect a course. "Such protection may prevent unauthorized access to the course..." *Id.* Obviously, if a course is taken and online content is linked, the instructor can change the password to prohibit subsequent access to the online content.

As stated at MPEP § 2164.01, "a patent need not teach, and preferably omits, what is well known in the art." Although not expressly contained in the specification, the prohibition concept claimed is within the skill of the ordinary artisan and supported by the specification. Therefore, the present rejection should be withdrawn and any enablement rejections should not be made.

**35 U.S.C. § 102(e)**

The Examiner maintains his rejection of claims 70-72, 74-76 and 78-80 as anticipated under 35 U.S.C. § 102(e) by Gupta. Claims 72, 76 and 80 were cancelled in the amendment dated May 17, 2006. Therefore, claims 70, 71, 74, 75, 78 and 79 remain at issue in the Final Rejection. Claims 70, 74 and 78 are independent claims.

Gupta provides a mechanism of sharing annotations among computers that exhibit different resolutions, bandwidths or presentation lengths (see page. 1, para. 7). Although recognizing that the annotations can be associated with "classroom discussion," Gupta does not address online learning software. As discussed with respect to the written description rejection, Gupta does not even provide a mechanism for users to store notes at their location because Gupta is more concerned with providing space-efficient storage of the annotation while still enabling the annotation to be viewed by different computer systems.

The Examiner states that Gupta discloses providing access to the entered notes *after* the completion of the interactive learning course, at page 1, paragraph 6, which states "some systems allow a user to select a particular one of these annotations and begin playback of the presentation..."

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Applicants respectfully disagree. As Gupta does not focus on online learning software, Gupta's disclosure does not address the time period at which a course is completed. One of ordinary skill in the art would recognize that, after a course is completed, the presentation would no longer be available and, therefore, "playback of the presentation" would not be an option. Therefore, Gupta does not teach access to the entered notes *after completion* of the interactive learning course.

The Examiner states that Gupta discloses Applicants' independent claim limitation "limiting subsequent access to the entered notes to the user only" at page 7, paragraph 90 because Gupta's use of controls clearly allow limiting access to the user only. Applicants respectfully disagree. While Gupta's use of controls may allow the user to limit access to only the user *during* the course, the controls do not address or envision *subsequent* access to the entered notes. In other words, Gupta neither envisions nor discloses access to notes associated with a course *after completion* of the course. This is more evident from the fact that Gupta maintains the annotations at the annotation server (abstract), not at the user's location. Clearly, based on the system utilized by Gupta, if the user no longer has access to the course, the user no longer has access to his or her notes.

Applicants maintain that Gupta does anticipate the limitations of its independent claims and, therefore, respectfully request withdrawal of the present rejection.

**35 U.S.C. § 103(a)**

The Examiner maintains his rejection of dependent claims 73, 77 and 81 as unpatentable over Gupta in view of Bohlen et al., "The effect of Learning Style and Method of Instruction on the Achievement, Efficiency and Satisfaction of End-Users Learning Computer Software" ("Bohlen"). The Examiner states that Gupta fails to explicitly describe controls for the learning material. The Examiner states that Bohlen teaches subject matter testing and that it is well known in the educational arts that testing is traditionally undertaken after completion of the learning course in a closed book environment. According to the Examiner, it would be obvious to combine Bohlen's prohibition of access to learning course material with the annotations control of learning course documents in Gupta in order to effectively test learning course students as to the degree of effectiveness of the learning course. However, access to a user's notes would also be prohibited during testing. Therefore, the Examiner's proposed combination teaches away from the limitation contained in Applicant's independent claims, from which the dependent claims depend, and the rejection should be withdrawn.

Respectfully submitted,

By: 

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